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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,662	01/30/2001	Albert Zorko Abram	A33760PCTUSA	3549

20872 7590 05/23/2003

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EXAMINER

OSTRUP, CLINTON T

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 05/23/2003

27

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application N .

09/719,662

Applicant(s)

ABRAM, ALBERT ZORKO

Examiner

Clinton Ostrup

Art Unit

1614

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 01 May 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 34.

Claim(s) objected to: _____.


Claim(s) rejected: 1-18 and 20-33.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: the arguments have not been found convincing. First, in regard to the new matter rejection, although the specification may provide antecedent basis for the specific active ingredient clobetasol, it simply does not provide antecedent basis for any and all active ingredients, as claimed. Moreover, because clobetasol is soluble in chloroform does not mean that applicant has provided written description and enablement, as required under 35 U.S.C. 112, first paragraph, for any active ingredient to be solubilized in the composition but not solubilized in the occlusive agent. Actually, all that applicant has done is shown an inherent characteristic of one specific active ingredient, namely clobetasol is soluble in chloroform, not that clobetasol is insoluble in both the water and occlusive agent. Therefore the New Matter rejection has been MAINTAINED. Applicant's submission and arguments of the prosecution history of the Davis patent are not convincing. Furthermore, the prosecution history of Davis is not at issue in the instant application. The rejection was made on the Davis reference itself, not the prosecution history of the reference, and what the reference taught and suggested to the skilled artisan. Applicants argument that an occlusive agent is not taught by Woodford et al is not convincing because the nonionic emulsifying wax meets the limitation of claim 18 wherein the occlusive agent does not even have to be present (i.e. no lower limitation) and because applicant has defined an occlusive agent as any excipient or combination thereof that provides an occlusion layer or hydration barrier to the skin and an occlusion layer or hydration barrier is a layer or barrier sufficient to result in reduction in trans epidermal water loss, which results in skin hydration. The nonionic emulsifying wax meets this limitation; therefore, the rejection has been MAINTAINED. Also, the fact that Woodford teaches the application of a polyester film does not necessarily mean they do not already have an occlusive layer, it simply means they desire an additional polyester occlusive layer.

The examiner respectfully acknowledges the 37 CFR 1.132 Declaration submitted by Ronald Harding, however, said declaration has not made the prior art rejection moot. Mr. Harding states that Woodford et al do not teach an occlusive agent because the term wax is not synonymous with occlusion and the Polarwax A31 does not contain any ingredients that are considered occlusive agents and when this Polarwax A31 is precipitated onto the skin it is not occlusive. The examiner respectfully disagrees. Applicants have defined an occlusive agent as any excipient or combination thereof that provides an occlusion layer or hydration barrier to the skin and an occlusion layer or hydration barrier is a layer or barrier sufficient to result in reduction in trans epidermal water loss, which results in skin hydration. Polarwax A31 will cause the a reduction in trans epidermal water loss, and therefore meets the occlusive agent as defined by applicants .


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PRIMARY EXAMINER
GROUP 100
